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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,820	09/26/2003	Michael C. Jones	DEP5086	6924
27777	7590	08/10/2006	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			SWIGER III, JAMES L	
			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/671,820		JONES, MICHAEL C.	
	<b>Examiner</b>		<b>Art Unit</b>	
	James L. Swiger		3733	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6,7,14,15 and 20-31 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6,7,14,15 and 20-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some \* c) ☐ None of:
    - 1. ☐ Certified copies of the priority documents have been received.
    - 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| <ul style="list-style-type: none"> <li>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</li> <li>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> <li>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br/>Paper No(s)/Mail Date _____.</li> </ul> | <ul style="list-style-type: none"> <li>4) <input type="checkbox"/> Interview Summary (PTO-413)<br/>Paper No(s)/Mail Date. _____.</li> <li>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</li> <li>6) <input type="checkbox"/> Other: _____.</li> </ul> |
|---|---|

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claim 6-7, 14-15, and 20-31 have been considered but are moot in view of the new ground(s) of rejection.

### ***Allowable Subject Matter***

The indicated allowability of the previously objected claims (6-7 and 14-15) and newly submitted and rewritten claims 6 and 14 is withdrawn in view of the newly discovered reference(s). Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Aginsky (US Patent 4,204,531). Aginsky discloses a device that is capable of compacting bone material that expands having a first component (22) that has a longitudinal axis (along item 7) and a second component (10/12) that is movably associated with the first component. The second component is also capable of moving outwardly in a radial direction (compare Figs. 2 and 3). Also, at least the first portion is considered to have a void (see relative space at the bottom of Figs. 1 and 3) that is cooperated with by the second component by a protrusion (see pointed edges of 11') for cooperation with the

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void . Further, when these two portions, or at least the second portion is fully extended, it interlocks outwardly (Figs. 6 and 7) within the void.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

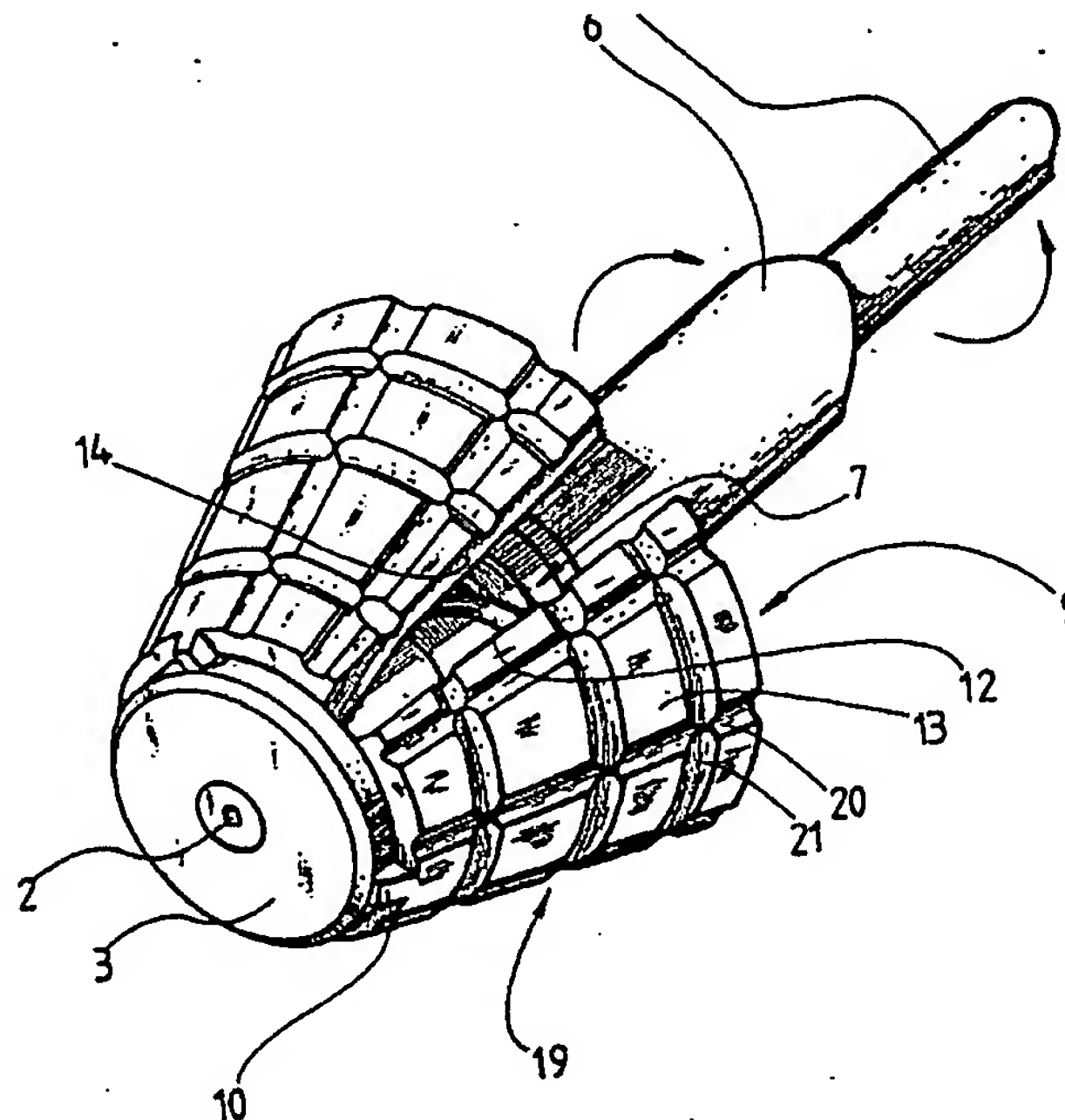
Claims 20-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aginsky in view of Parhofer et al. (Foreign Patent DE3630069). Aginsky discloses the claimed invention except for:

- A body
- A stem
- A taper along a longitudinal axis of at least one of the components
- A restraining/cooperating portion
- A third component, moveable at least partially in a radial direction
- A second component defining a first surface for cooperation with a first component, and is adapted to urge particles radially from the longitudinal axis

Parhofer et al. discloses a device having a first component defining a longitudinal axis (see Fig. 3, item 1), and a second component (19) movably associated with the first component (see joint at 10) in a radial direction (Fig. 2). The device further has a body (Fig. 3), and a stem extending from said body (6), and wherein the second component

is tapered (Fig. 1). The device also has a restraining portion (8) and a cooperating portion of the second component (10) to provide restrained motion. The device also has a third component moveably associated with the first component (See Fig. 2 below, and the section denoted as "3" is the third component).

Fig.2



Further, the internal side of component 2 has a surface associated with the first component (on the inside) while the second component has a surface capable of contact with bone material and that is also capable of urging the particles radially (see Col. 2 through Col. 3). The device also provides for a motion of the second component away from the longitudinal axis of the first component as the first component is advanced axially (Col. 5, lines 41-63).

With regards to claim 19, the device as claimed is inherently capable of performing the method that is comprised of a device with a first and second component and having a second component that may move in a radial direction. To use the device

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as it was intended an incision of some kind is required. Likewise, the instrument would not fit into the bone cavity without proper preparation.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Aginsky having the *above bulleted* items in view of Parhofer et al. to better enable the device to compact bone.

Claims 14-15 and 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parhofer et al. '069 in view of Aginsky. Parhofer et al. discloses the invention listed *supra*, but lacks a void in either the first or second component, and wherein a protrusion cooperates with the void of the other component, respectively.

Aginsky discloses a device that is capable of compacting bone material that expands having a first component (22) that has a longitudinal axis (along item 7) and a second component (10/12) that is movably associated with the first component. The second component is also capable of moving outwardly in a radial direction (compare Figs. 2 and 3). Also, at least the first portion is considered to have a void (see relative space at the bottom of Figs. 1 and 3) that is cooperated with by the second component by a protrusion (see pointed edges of 11') for cooperation with the void. Further, when these two portions, or at least the second portion is fully extended, it interlocks outwardly (Figs. 6 and 7) within the void. This expanding portion comprising the voids expands and locks in the void portion (see Col. 3, lines 18-33). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Parhofer et al. having at least a first and second portion interlock

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with the other, filling a void in view of Aginsky to better secure the two portions together to compact bone.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See pto-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JS 8/6/03

  
EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER